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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,486	04/25/2001	Yasuo Iwasa	Q63961	4521

7590 12/01/2005

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EXAMINER

VO, HAI

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/841,486

Applicant(s)

IWASA ET AL.

Examiner

Hai Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-11 and 13-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-11 and 13-19 is/are rejected.
- 7) ☒ Claim(s) 20 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. All of the art rejections are maintained.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 8-10, and 13-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 99/46117 substantially as set forth in the 04/20/2005 Office Action.
5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/46117 as applied to claim 1 above, and further in view of JP 07-195827.

***Response to Arguments***

6. The art rejections over WO 99/46117 taken alone or in combination with JP 07-195827 have been maintained for the following reasons. Applicants argue that the resin powdery composition of Arai et al cannot form an independent self-supporting ink-receiving layer and is completely different from the stretched porous resin film of the present invention. The examiner disagrees. In the first place, Applicants'

arguments are not found commensurate in scope with the claims. Nothing in the claims is specific about “self-supporting stretched porous resin film”. Therefore, the arguments are not relevant to the claim limitations. Secondly, Arai teaches the powdery coating composition having a thickness from 1 to 100 microns with the range disclosed in the specification of the present invention. Thus, it is not seen that the powdery coating composition could not have been of a self-supporting film as it has the same thickness as the stretched porous resin film of the present invention. Applicants argue that the term “film” and “stretched” in the present claims define structural and physical elements of the claimed invention that render it unobvious over the ink receiving layer of Arai et al. The examiner disagrees. The examiner directs Applicants to column 10, lines 10-20 and figure 2. Arai discloses a porous continuous resin layer 25 comprising particles of powdery coating composition 22 and a continuous film 24 of inorganic fine particles as shown in figure 2. Likewise, Arai discloses the porous resin film as well. It is agreed that Arai does not specifically disclosed the stretched powdery coating composition. Such an absence does not necessarily mean that the powdery coating composition of Arai cannot be stretched as argued by Applicants. Further, since Applicants failed to provide any evidence or affidavit to support for Applicants' arguments, the arguments are not found persuasive to overcome the art rejections. Note that the “stretched” is not a structural limitation but rather a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the porous resin film of Arai is identical to or only slightly different than the claimed porous resin

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film prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. The porous resin film comprises 95 parts by weight of a mixture of hydrophilic and hydrophobic resins and 5 parts of an inorganic fine powder (example 10). The ratio of the amount of the hydrophilic resin to the amount of the hydrophobic resin is 5:95 to 1 within the claimed range. The porous resin film is prepared by kneading (column 9, lines 40-45). The inorganic fine powder has an average particle size of 1 to 5 microns (column 8, lines 32-35). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Arai. Accordingly, the art rejections are sustained.

***Allowable Subject Matter***

7. Claims 20 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Arai discloses an ink jet recording medium comprising a substrate and a porous resin film containing colorants. One of skilled in the art would not be motivated to add an additional colorant fixing layer on at least one side of the porous resin film from the impractical view of the weight and cost concern.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

*Hai Vo*

**HAI VO  
PRIMARY EXAMINER**